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*IP*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/495,668 02/01/00 SELIFONOV

S 3271.002US1

HM12/0825

EXAMINER

Majestic, Parsons, Siebert & Hsue P.C.  
Four Embarcadero Center  
Suite 1100  
San Francisco CA 94111-4106

KIM, Y

ART UNIT	PAPER NUMBER
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1631

*5*

DATE MAILED:

08/25/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/495,668	SELIFONOV ET AL.
	Examiner	Art Unit
	Young J. Kim	1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_ .

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-44 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 17-26 and 29-44 is/are allowed.

6) Claim(s) 1-16, 27 and 28 is/are rejected.

7) Claim(s) 1, 15-16 is/are objected to.

8) Claims \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some \* c) None of the CERTIFIED copies of the priority documents have been:

1. received.

2. received in Application No. (Series Code / Serial Number) \_\_\_\_ .

3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ .

18) Interview Summary (PTO-413) Paper No(s) \_\_\_\_ .

19) Notice of Informal Patent Application (PTO-152)

20) Other: *Sequence Compliance Notice* .

## **DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has been assigned to Art Unit 1631. All further correspondence regarding this application should be directed to Group Art Unit 1631.

### *Specification*

The specification is objected to by the Examiner because it makes reference to an URL on the internet. For example, line 24 of page 14, lines 5-12, page 37 contains web-address. While information on web-address is accessible, the embedded hyperlinks and/or other forms of browser-executable code are impermissible and require deletion. The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. See MPEP 608.01(p), paragraph I regarding incorporation by reference.

If the subject matter which is improperly incorporated by reference is directed to nonessential material (illustrating the state of the art), the deletion will probably not be considered as new matter. However, if the subject matter which is improperly incorporated by reference is directed to essential material, applicant will be required to amend the specification to include the subject matter incorporated. The amendment must be accompanied by an affidavit or declaration executed by the applicant stating that the amendatory material consists of the same material incorporated by reference.

The specification fails to comply with the Sequence Rules as set forth in 37 CFR 1.821 through 1.825. The specification contains a nucleic acids sequence which is more than 10 nucleotides long in line 7, page 22. (See the attached Sequence Compliance Notice).

***Claim Objections***

Claims 1 and 15-16 are objected to because of the following informalities: Claim 1 recites a grammatically incorrect phrase, “encoding two or more a biological molecules into character strings” [emphasis added]. Claim 15 and 16 contains a period in the middle of the claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 and 27-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-16 are indefinite for the recitation of the term “subunits.” It is unclear whether the subunits mean each letter corresponding to the nucleotides of a nucleic acid or a length of bytes required for the character string.

Claim 6 is indefinite for the recitation of the phrase, “biological molecules have at least 30% sequence identity.” It is unclear to what the biological molecules are compared to in determining the sequence identity.

Claims 27-28 recite the limitation "said method." There is insufficient antecedent basis for this limitation in the claim.

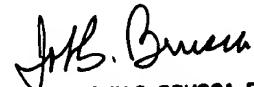
### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yokomori et al., (1993) disclose a simple string similarity measure to analyze molecular evolution. Yokomori et al., however, do not teach or suggest a method of concatenation of two random strings which represent biological molecules to derive a product string, ultimately resulting in mimicking of molecular evolutionary process.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (703) 308-9348. The Examiner can normally be reached from 8:30 a.m. to 6:00 p.m. on weekdays. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028. Papers related to this application may be submitted to Art Unit 1631 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. The Fax number is (703) 308-0294. Please call the Examiner at (703) 308-9348 before the transmission to expedite delivery of the fax. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Young J. Kim  
08/11/00

  
JOHN S. BRUSCA, PH.D  
PRIMARY EXAMINER

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- 7. Other: \_\_\_\_\_

**Applicant Must Provide:**

- An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216  
For CRF Submission Help, call (703) 308-4212  
For PatentIn software help, call (703) 308-6856